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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,057	07/16/2003	Steven Jonathan Spinner	035334-006	2279

7590 03/27/2007  
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EXAMINER
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GISHNOCK, NIKOLAI A

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

ED

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/622,057		SPINNER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Nikolai A. Gishnock		3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/20/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3714

### **DETAILED ACTION**

With respect to Applicant's remarks filed 1/23/2006, claims 1-13 are cancelled. Claims 14-25 are pending.

#### ***Allowable Subject Matter***

1. The indicated allowability of claims 14-25 is withdrawn in view of the newly discovered reference(s) to Garner, II (US 2003/0084042), hereinafter known as Garner. Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections – 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3714

3. Claims 14, 16-22, & 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Garner.

- Garner discloses a method for evaluating a person's athletic ability (method for comparing genomic sequences to evaluate potential for success in sports, Para 0017) and a program storage device readable by machine (Para 0088) comprising: subjecting the person to a plurality of tests (sports profile module reads in the genomic sequences from the prospect, Para. 0066 & 0071; It is inherent that the comparison of genetic sequences of a prospect is a plurality of tests, one for each gene corresponding to a trait that is to be considered beneficial for success at a sport); comparing the results of said plurality of tests with a database, including the results of tests subjected to a set of athletes from different physical activities (profile module compares the input sequence to the sequences of champions from the genomic sports profile database/scorecard, Para. 0072-0073); identifying at least one specific physical activity most compatible with the person based on comparing (evaluation results display module evaluates baseball pitcher prospects and establishes a rank, Para. 0126; also Figure 7, Items 71 & 73); and displaying at least one specific physical activity most compatible with the person (Display Mode Selection Module displays correlation scores, name & ranking of prospect, etc., Para. 0124) [Claims 14 & 22].
- Garner discloses a system for evaluating a person's athletic ability comprising: a server having a CPU and a memory (Genomic Sports Profile computer system,

Para. 0068; also Figure 2, Item 10), and a database storing results of a plurality of tests subjected to a set of athletes from different physical activities (genomic information from each champion is correlated and collected into a relational database, Para.0064-0065); a plurality of testing locations (access to the genomic sports profile e-marketplace by sports teams is obtained through computer terminals coupled to a central server through a computer network, Para 0133), each having a plurality of testing tools used for subjecting the person to a plurality of tests (validation is performed using a sports team to provide fruitful analysis for each team, sport, and position based upon requirements set forth by each team, Para. 0141; testing includes validation of a data base directed to identifying which genomic sequences are common to pitchers on baseball teams, and which are absent; pitchers are then ranked based on the correlation between respective and identified sequences, Para. 0143; It is inherent that the plurality of testing tools are standard laboratory equipment used in DNA analysis, such as a thermocycler, UV transilluminator, and a computer processor for sequencing genomes), wherein the results of the tests from the person are temporarily stored in memory (Para. 0088), CPU comparing the results in the database, and correlating at least one specific physical activity most compatible with the person based on the comparison (correlation score is assigned to each prospect, indicating how closely the prospect correlates to champions and to unsuccessful prospects, correlation score is stored in the database/scorecard for future

Art Unit: 3714

access, Para. 0059), and identifying at least one specific physical activity most compatible with the person (Para. 0126). [Claims 16 & 24].

- Garner disclose wherein each testing location further comprises a computing device communicating with a server through a plurality of networks, receiving the results of the tests from the person (Genomic Sports Profile computer system is based upon a server executing a module which accesses database/scorecard, using a relational database, in an implementation that allows remote access using the Internet, Para. 0062 & 0069) [Claim 17].
- Garner discloses wherein the computing device or server visually displays the results of a plurality of tests with the results from a set of athletes from a specific physical activity most or least compatible with the person (a correlation score is established by comparing the genomic sequence to the composite sequences of champions; if a sequence is determined to be common to prior prospects who have tried and failed, but not common to champions, than a negative numerical value is assigned, Para. 0083-0084) [Claims 18-21].

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3714

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 15, 23, & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garner, in view of *Human Gene for Physical Performance*, Nature, Vol. 393 (21 May 1998), Pp. 221-2, hereinafter referred to as Nature.

- Garner teaches all the features as demonstrated in the rejections of claims 14, 22, & 24 above, including displaying the results of a plurality of tests of a set of athletes from at least one physical activity with respect to a plurality of tests from a person. Garner also teaches a graphical user interface format for presenting the correlations of the Genomic Sports Profile database/scorecard (Para. 0111). What Garner fails to teach is means for displaying at least one graph illustrating the results. However, Nature presents a graph of the association of the presence of A and I alleles of the ACE genotype of 25 elite mountaineers with respect to 1,906 healthy men (Figure 1a, Page 221). The graph represents the plurality of tests (insertion and deletion alleles of the ACE genome) of a set of athletes (mountaineers) with respect to a plurality of tests of persons (healthy men).

Art Unit: 3714

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have displayed the results in the apparatus and method of Garner, in the graph format as illustrated in Nature, in order to permit ease of viewing, understanding, and customizing the display of the results of the correlations [Claims 15, 23, & 25].

### ***Response to Arguments***

7. Applicant's arguments filed 1/23/2006, with respect to claims 1-7 & 9-13, see page 5, have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Allison (US 2003/0218625 A1) discloses a GUI database for recruiters to review and analyze the talents of athletes.
- Cobb (US 2004/0249299 A1) discloses a database of physiologic test results of patients.
- Hitoshi (JP 10009550 A) discloses a plurality of amusement games that evaluate physical aspects of a player.
- Silina et al. (RU 2206273 C1) discloses a plurality of physical tests for evaluating athletes.

This Action is made NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolai A. Gishnock whose telephone number is 571-272-1420. The examiner can normally be reached on M-F 8:30a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*NAG*  
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3/5/2007

*Kathleen Mosser*  
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PRIMARY EXAMINER